REMARKS

The Applicants have received the Office action dated October 16, 2008, which 1) rejects claims 1-15 under 35 U.S.C. § 101; 2) rejects claims 16-58 under 35 U.S.C. § 102 over Yates et al. (U.S. Patent No. 7,111,290) hereinafter "Yates".

With this Response, the Applicants amend claims 1, 16, 33, 41, 47, and 55, and cancel claims 4, 13, 28, 38, 43, 51, and 57.[1] Therefore, after entry of this Response, claims 1-3, 5-12, 14-27, 29-37, 39-42, 44-50, 52-56, and 58 remain pending.

I. Claim Rejections Under 35 U.S.C. § 101

The Office action rejects claims 1-15 as allegedly directed to non-statutory subject matter. Without conceding the merits of the rejection and solely to advance prosecution, independent claim 1 is amended to recite a "tangible computer readable storage medium comprising a computer-implemented software tool.[2]

The Applicants respectfully submit that the claims, as amended, are directed to statutory subject matter, in compliance with 35 U.S.C. § 101 and respectfully request such indication.

II. Claim Rejections Under 35 U.S.C. § 102

The Office action rejects claims 1-58 under 35 U.S.C. § 102(e) as allegedly anticipated by Yates. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Applicants respectfully traverse the § 102 rejections because Yates simply does not teach or suggest "each and every element as set forth in the claim" either expressly or inherently.

For example, independent claim 1, as amended, requires (emphasis added)

> a computer-implemented software tool that determines at least one data
> address from one or more instruction instances, and that identifies one or
> more memory reference objects, which are associated with the data address,
> as hindering execution of code that includes the instruction instances
> correspond to the code execution hindrance, wherein the memory reference
> objects include virtually addressable memory.

Yates appears to be directed to a method of profiling program execution to identify frequently and infrequently executed regions of the program to be determined (*see Yates, column 2, lines 14-25*), and not necessarily identifying hindering code. Nevertheless, even if Yates did teach identification of hindering code, Yates fails to teach or suggest that the

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[1] Support for these amendments is found at least in original claim 3.
[2] *Ex parte Bo Li*, Appeal 2008-1213 (BPAI 2008) (affirming *Beauregard* claims post *In re Bilski*).

location within the computer system at which program code is being hindered <u>is a virtual</u> <u>memory location</u> as required by claim 1. In fact, Yates teaches the opposite: "profiler 400 tracks events by physical address, <u>rather than by virtual address</u>". *Yates, col. 55, ll. 47-48 (emphasis added); see also col. 29, 7-9.* For at least this reason, claim 1 and its dependent claims (claims 2-15) are not anticipated by Yates.[3]

Independent claims 16, 33, 41, 47, and 55, as amended, contain limitations akin to claim 1, and therefore, claims 16, 33, 41, 47, and 55, and their dependent claims (claims 17-27, 29-32, 34-37, 39, 40, 42, 44-46, 48-50, 52-54, 56, and 58) are not anticipated by Yates for at least the same reason as claim 1.

III. Conclusion

The Applicants thank the Examiner for his thorough review of the application. The Applicants respectfully submit the present application, as amended, is in condition for allowance and respectfully request the issuance of a Notice of Allowability as soon as practicable.

The Applicants believe no fees or petitions are due with this filing. However, should any such fees or petitions be required, please consider this a request thereof and authorization to charge Deposit Account No. 04-1415 as necessary.

If the Examiner should require any additional information or amendment, please contact the undersigned attorney.

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Respectfully submitted,

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[3] Furthermore, since Yates teaches directly against a requirement of claim 1, it is difficult to imagine how Yates could be combined with another reference, for example in a future obviousness rejection, to render the claims obvious.